

REMARKS

This paper includes a complete and timely response to the non-final Office Action mailed March 4, 2004 (Paper No. 13). Claims 2 - 22 and 25 - 30 remain pending. Claims 7 and 16 - 18 have been amended. The subject matter of amended claims 7 and 16 - 18 can be found at least on pages 7 and 8 of the application. Consequently, no new matter is added to the present application. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

In response to the rejection of claims 1 - 27, Applicants submit that the proposed combination of Flowers in view of Ying does not disclose, teach, or suggest all claim limitations.

Applicants note that claims 28 - 30 have not been rejected. Accordingly, any subsequent Office Action that includes a rejection of these claims must be non-final as such a rejection would necessitate new grounds for the rejection that were not necessitated by the Applicants.

Each rejection presented in the non-final Office Action mailed March 4, 2004 is discussed in detail in the following remarks.

Response to 35 U.S.C. §103 Rejections – Claims 1 - 27

A. Statement of the Rejection

The Office Action indicates that claims 1 - 27 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 5,533,174 to Flowers *et al.* ("*Flowers*") in view of International Publication Number WO 01/18681 A2 to Ying *et al.* ("*Ying*").

B. Discussion of the Rejection

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Applicants canceled claim 1 in a previous amendment. Consequently, the rejection of claim 1 is moot.

Applicants respectfully traverse the rejection of claims 2 - 27 for at least the reason that the cited references fail to disclose, teach, or suggest each element and/or

method step in the claims. Applicants respectfully request that the Office reconsider the rejection.

1. Claims 2 - 15

For convenience of analysis, Applicants' independent claim 7, as amended, is repeated below in its entirety.

7. A method for distributing and installing print device fonts, the method comprising:
maintaining a web site which facilitates selection from a set of print device-ready fonts;
via the web site, obtaining information concerning a visitor's system configuration;
via the web site, receiving a request for a set of fonts for purchase;
via the web site, ***displaying potential estimated performance gains that may result from the purchase of a set of fonts other than the set of fonts requested by the visitor, wherein potential estimated performance gains comprise a characteristic of a print job executed with a print device installed font;***
via the web site, permitting selection, by the visitor, from the set of fonts requested and the set of fonts other than the set of fonts requested;
via the web site, authorizing transfer of the set of fonts selected; and
via the web site, installing the set of fonts selected on a print device corresponding to the visitor.

(Applicants' Claim 7 - *emphasis added*.)

Applicants respectfully submit that the proposed combination of *Flowers* in view of *Ying* does not render Applicants' claimed invention obvious for at least the reason that neither *Flowers* nor *Ying* disclose, teach, or suggest at least the emphasized limitation of claim 7. Specifically, neither *Flowers* nor *Ying* disclose, teach, or suggest "***displaying potential estimated performance gains that may result from the purchase of a set of fonts other than the set of fonts requested by the visitor, wherein potential estimated performance gains comprise a characteristic of a print job executed with a print device installed font.***"

Concerning *Flowers*, the statement of the rejection acknowledges that *Flowers* does not disclose, via the Web site, displaying potential estimated performance gains that

may result from the purchase of a set of fonts other than the set of fonts requested by a visitor. Applicants agree.

Regarding *Ying*, the statement of the rejection alleges that *Ying* discloses displaying potential estimated performance gains that may result from the purchase of a set of fonts other than the set of fonts requested by a visitor. Applicants disagree. Applicants note that the statement of the rejection does not identify where *Ying* includes such a disclosure. FIGs. 68 and 71-74 apparently disclose a graphical user interface associated with a browser (*i.e.*, Netscape) that show a “best match” score associated with a plurality of available fonts. The best match score compares attributes of a sample portion of text provided by a visitor to the Web site with attributes associated with each of the available fonts. Graphically presenting a score associated with a comparison of font attributes does not disclose, teach, or suggest Applicant’s claimed limitation of **“displaying potential estimated performance gains . . . wherein potential estimated performance gains comprise a characteristic of a print job executed with a print device installed font.”** For at least this reason, the proposed combination fails to disclose, teach, or suggest each method limitation recited in Applicants’ claimed invention. Thus, the proposed combination fails to establish a *prima facie* case of obviousness for Applicants’ amended claim 7. Accordingly, independent claim 7 is allowable and the rejection should be withdrawn.

Because independent claim 7 is allowable, as discussed above, dependent claims 2 - 6 and 8 - 15, which depend either directly or indirectly from independent claim 7, are also allowable. *See In re Fine*, 837, F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Accordingly, Applicants respectfully request that the rejection of claims 2 - 15 be withdrawn.

2. Claims 16 and 26

For convenience of analysis, Applicants’ independent claim 16, as amended, is repeated below in its entirety.

16. A method for distributing print device fonts, the method comprising:

receiving information corresponding to a visitor accessing a web site, the web site providing a selection of fonts for purchase by the visitor;

receiving information, via the web site, corresponding to the visitor designating one or more of the fonts for purchase;

determining a visitor's system configuration;

displaying potential estimated performance gains, based upon the visitor's system configuration, resulting from installation of one or more fonts other than the one or more of the fonts designated, wherein potential estimated performance gains comprise a characteristic of a print job;

receiving information corresponding to the visitor selecting for purchase one or more of the fonts designated or one or more of the fonts other than the fonts designated; and

from the web site, in response to a purchase by the visitor, installing said selected one or more of the fonts on a print device of the visitor.

(Applicants' Claim 16 - *emphasis added*.)

Applicants respectfully submit that the proposed combination of *Flowers* in view of *Ying* does not render Applicants' claimed invention obvious for at least the reason that neither *Flowers* nor *Ying* disclose, teach, or suggest at least the emphasized limitation of claim 16. Specifically, neither *Flowers* nor *Ying* disclose, teach, or suggest "***displaying potential estimated performance gains, based upon the visitor's system configuration, resulting from installation of one or more fonts other than the one or more of the fonts designated, wherein potential estimated performance gains comprise a characteristic of a print job.***"

As discussed above regarding Applicants' independent claim 7, the statement of the rejection acknowledges that *Flowers* does not disclose this limitation.

Concerning *Ying*, the statement of the rejection alleges that *Ying* discloses displaying potential estimated performance gains that may result from the purchase of a set of fonts other than the set of fonts requested by a visitor. Applicants disagree. FIGs. 68 and 71-74 apparently disclose a graphical user interface associated with a browser (*i.e.*, Netscape) that show a "best match" score associated with a plurality of available fonts. The best match score compares attributes of a sample portion of text provided by a visitor to the Web site with attributes associated with each of the available fonts. Graphically presenting a score associated with a comparison of font attributes does not disclose, teach, or suggest Applicant's claimed limitation of "***displaying potential estimated performance gains, based upon the visitor's system configuration, resulting from installation of one or more fonts other than the one or more of the fonts***

designated, wherein potential estimated performance gains comprise a characteristic of a print job.” For at least this reason, the proposed combination fails to disclose, teach, or suggest each method limitation recited in Applicants’ claimed invention. Thus, the proposed combination fails to establish a *prima facie* case of obviousness for Applicants’ amended claim 16. Accordingly, independent claim 16 is allowable and the rejection should be withdrawn.

Because independent claim 16 is allowable, as discussed above, dependent claim 16, which depends from independent claim 16, is also allowable. *See In re Fine, supra.* Accordingly, Applicants respectfully request that the rejection of claims 16 and 26 be withdrawn.

3. Claims 17 – 22 and 27

For convenience of analysis, Applicants’ independent claim 17, as amended, is repeated below in its entirety.

17. A web site for distributing print device fonts, the web site being accessible over the Internet and comprising software for:

 permitting a visitor to select fonts compatible with that visitor’s system configuration;

displaying potential estimated performance gains which may result from installation of a font not previously selected by the visitor, wherein potential estimated performance gains comprise a characteristic of a print job;

 determining whether to authorize installation of a selected one or selected multiple compatible fonts; and

 installing said selected one or selected multiple compatible fonts on a visitor’s print device in response to an authorization determined in said step of determining.

(Applicants’ Claim 17 - *emphasis added.*)

Applicants respectfully submit that the proposed combination of *Flowers* in view of *Ying* does not render Applicants’ claimed invention obvious for at least the reason that neither *Flowers* nor *Ying* disclose, teach, or suggest at least the emphasized limitation of claim 17. Specifically, neither *Flowers* nor *Ying* disclose, teach, or suggest Applicants’ claimed “***displaying potential estimated performance gains which may result from installation of a font not previously selected by the visitor, wherein potential estimated performance gains comprise a characteristic of a print job.***”

As discussed above regarding Applicants' independent claim 7, the statement of the rejection acknowledges that *Flowers* does not disclose this limitation.

Concerning *Ying*, the statement of the rejection alleges that *Ying* discloses displaying potential estimated performance gains that may result from the purchase of a set of fonts other than the set of fonts requested by a visitor. Applicants disagree. FIGs. 68 and 71-74 apparently disclose a graphical user interface associated with a browser (*i.e.*, Netscape) that show a "best match" score associated with a plurality of available fonts. The best match score compares attributes of a sample portion of text provided by a visitor to the Web site with attributes associated with each of the available fonts. Graphically presenting a score associated with a comparison of font attributes does not disclose, teach, or suggest Applicant's claimed limitation of "***displaying potential estimated performance gains which may result from installation of a font not previously selected by the visitor, wherein potential estimated performance gains comprise a characteristic of a print job.***" For at least this reason, the proposed combination fails to disclose, teach, or suggest each method limitation recited in Applicants' claimed invention. Thus, the proposed combination fails to establish a *prima facie* case of obviousness for Applicants' amended claim 17. Accordingly, independent claim 17 is allowable and the rejection should be withdrawn.

Because independent claim 17 is allowable, as discussed above, dependent claims 18 - 22, and 27, which depends from independent claim 17, are also allowable. *See In re Fine, supra.* Accordingly, Applicants respectfully request that the rejection of claims 17 - 22, and 27 be withdrawn.

Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.


CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 2 - 22 and 25 - 30 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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